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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,873	12/31/2001	Yi-Lin Wu	4006-142	4014

7590 08/26/2005

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EXAMINER

REAGAN, JAMES A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/029,873

Applicant(s)

WU, YI-LIN

Examiner

James A. Reagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the response filed on 21 June 2005.
2. Claims 1-17 have been examined.

## **RESPONSE TO ARGUMENTS**

3. Applicant's arguments received on 21 June 2005 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claim 1, Applicant argues that Marmor does not disclose file fingerprints. The Examiner agrees, and uses the teaching of Stefik to offset any deficiencies in Marmor. See the rejections below. Applicant goes on to assert that Stefik uses the Hash function for a separate purpose other than the purposes claimed. This is irrelevant. The system of hashing as disclosed by Stefik is equivalent to the system claimed by the applicant. A message digest i.e. fingerprint is generated and then is compared.

With regard to claims 1, 4, 6, 7, 8, 9, 10, 12, 13, 14, 15, 16 and 17, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Applicant either failed to traverse the Examiner's assertion of Official Notice or failed to traverse the Examiner's assertion of Official Notice adequately. To adequately traverse the

examiner's assertion of Official Notice, the Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Applicant's assertion of should be included.

#### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marmor et al. (US 2002/0062310 A1) in view of Harris (US 2002/0059204 A1), and further in view of Stefik et al. (US 5,629,980 A).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 4, 6, 7, 10, 12, 13, 14, 15:**

Marmor discloses a peer-to-peer digital file-sharing network, thereby disclosing the following limitations:

- *using the network connecting abilities of the copyright management system and the first digital processing device to connect the copyright management system with a copyright database of a platform service provider;*
- *uploading at least a first member account name of the copyright owner, the file fingerprint, the filename of the digital file, and a price to the copyright database for registration;*
- *uploading at least a second member account name of the file provider, the file fingerprints of the digital files, and the filenames of the digital files to the copyright database for comparing with the registered digital files provided by the copyright owner;*
- *the network connecting abilities comprises Internet connecting abilities;*
- *the digital files are computer files;*

Marmor does not disclose a distributed search system that can query multiple databases over a P2P network. See at least paragraph 004 as well as other associated and relevant text. Harris, however, in at least paragraph 0007 as well as other associated and relevant text does, thereby disclosing the following limitations:

- *providing a first search sharing system installed on a second digital processing device of a file provider;*
- *providing a second search sharing system installed on a third digital processing device of a consumer;*
- *using the network connecting abilities of the second search sharing system and the third digital processing device to connect the second search sharing system with the copyright database of the platform service provider;*

- *using the network connecting abilities of the second search sharing system, the third digital processing device, the first search sharing system and the second digital processing device to connect the second search sharing system with the first search sharing system, establishing a peer-to-peer network connection, and downloading the digital file from the first search sharing system to the second search sharing system;*
- *uploading at least one keyword for searching a digital file interested by the consumer;*
- *returning a search result according to the keyword from the copyright database to the second search sharing system for the consumer to select a source for the digital file;*
- *the first search sharing system and the second search sharing system are the same and consist of a computer software system.*
- *the searching result list is the result filtered out from the database according to the uploaded keyword from the consumer, the result providing the second search sharing system the ability to connect to the first search sharing system of the file provider who owns the digital file satisfying the conditions and to download the digital file;*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Harris and Marmor because Marmor discloses a multi-database peer-to-peer network, and Harris discloses a system for searching multiple, interconnected databases.

The combination of Marmor/Harris does not disclose file fingerprints *per se*, digital rights or the use of a Hash function to return a message digest i.e. fingerprint, of a specific digital file. Stefik, however, in at least column 42, lines 49+ as well as other associated and relevant text discloses using a hash function to protect the transfer of digital files, and in at least the abstract

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and other associated and relevant text disclosing attaching usage rights to a digital work, thereby disclosing the following limitations:

- *providing a copyright management system installed on a first digital processing device;*
- *using the operating abilities of the copyright management system and the first digital processing device to generate a file fingerprint for a digital file provided by a copyright owner;*
- *partitioning a data sharing area in the second digital processing device of the file provider so that the file provider can put a plurality of digital files to be shared in the data sharing area;*
- *using the operating abilities of the first search sharing system and the second digital processing device to generate file fingerprints for each of the shared digital files;*
- *the file fingerprint includes a string generated according to the MD5 algorithm;*
- *the data sharing area is a computer file folder;*
- *each of the digital files shared by the file provider is compared with one registered in the copyright database using the file fingerprint data.*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Harris/Marmor with Stefik because Marmor and Harris discloses a multi-database peer-to-peer network, while Stefik discloses the transfer of copyright-protected digital files over a distributed network using hash functions as a security device. MD5 is a well-known standard in the industry.

The combination of Marmor/Harris/Stefik does not disclose:

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- *deducting network points of the consumer in the copyright database and allotting the network points to the member accounts of the copyright owner, the file provider, and the platform service provider in proportion;*
- *the network points are tokens for network transactions that can be cashed at the platform service provider for equivalent currencies;*

However, the Examiner takes **Official Notice** that it is old and well-known in the computer transaction arts to use a points system to as currency to maintain control over the amount of transfers allotted to a user or provider of digital content over the Internet. Such point system may be used as incentive to promote transactions or to provide a source of revenue to the copyright owner.

**Claims 2 and 5:**

With regard to the limitations of:

- *the copyright management system only needs to be installed once and is able to be started at any time afterwards;*
- *the copyright management system comprises a computer software system;*

See at least Marmor paragraph 0009, as well as other associated and relevant text.

**Claim 3:**

With regard to the limitation of *the first digital processing device, the second digital processing device and the third digital processing device are computers*, see at least Marmor paragraph 0013, as well as other associated and relevant text.



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**Claim 11:**

With regard to the limitation of *the platform service provider offers services from a website center*, see at least Marmor paragraph 0011, as well as other associated and relevant text.

**Claims 8, 9, 16 and 17:**

With regard to the limitations of:

- *the first member account name is a private account of the copyright owner authorized by the platform service provider for tagging the copyright sources of the registered digital files;*
- *the price is set by the copyright owner;*
- *file registration withdrawal, in which the copyright owner uses the copyright management system to withdraw the copyright, preventing the digital file previously registered for sale from being shared and downloaded;*
- *locking a digital file, which provides a lock table for registering all fingerprints of the digital files to be shared so that the search sharing systems first check the lock table before searching, sharing and downloading, preventing locked files from being distributed without the permission and unlock from the creator and copyright owner;*

The Examiner takes **Official Notice** that these steps are merely design choices that are fundamental and necessary to ensure the security of security of the digital files, as well as to maintain the integrity of the databases and to maintain positive control over the use and availability of copyrighted materials contained within a digital file repository.

**Conclusion**

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**571-273-8300** [Official communications, After Final communications labeled "Box AF"]

**571-273-8300** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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JAR

17 August 2005



*James A. Reagan*  
**PRIMARY PATENT**